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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,233	04/05/2001	Cary Lee Bates	RSW920010047US1	7213
46583	7590	07/27/2010	EXAMINER	
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			ART UNIT	PAPER NUMBER
			2443	
			NOTIFICATION DATE	DELIVERY MODE
			07/27/2010	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARY LEE BATES, PAUL REUBEN DAY, JOHN MATTHEW
SANTOSUOSSO, and WAHEED SUJJAD

Appeal 2009-000840
Application 09/827,233¹
Technology Center 2400

Before THU A. DANG, CAROLYN D. THOMAS, and
DEBRA K. STEPHENS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL²

¹ Application filed April 5, 2001. The real party in interest is International Business Machines Corporation.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1-20, which are all the claims pending in the application. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

The present invention is a method for guiding the recipient of an email through a set of web pages carried by the email in a preferred viewing order. (Spec., 21, Abstract.)

Claim 1 is illustrative:

1. A method for providing email that enables a recipient of the email to navigate readily through a set of web pages associated with the email, comprising the acts of:

composing an email to be sent from an originator to a recipient;

[i]n response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient;

associating the navigation with the email; and

sending the email and the navigation to the recipient.

Appellants appeal the following three (3) rejections:

1. Claim 2 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention³.

³ We shall treat the rejection of claims 1-3, 8-11, and 16 under 35 U.S.C.

2. Claims 1-3, 5, 7, 9-11, 13, 15, and 17-20 under 35 U.S.C. § 102(e) as anticipated by Carter (US 6,859,213 B1, Feb. 22, 2005); and

3. Claims 4, 6, 8, 12, 14, and 16 under 35 U.S.C. § 103(a) as unpatentable over Carter and Bates (US 6,963,901 B1, Nov. 8, 2005).

FACTUAL FINDINGS

Specification

1a. Appellants' Specification discloses that "the order in which URLs appear in the navigation 300 may itself convey the preferred viewing order of the web pages. Thus, in this embodiment the conveyance of the preferred viewing order by the navigation 300 is implicit rather than explicit." (10:3-6.)

1b. Appellants' Specification discloses that "[t]he navigation includes a set of URLs that identify web pages to be viewed by the recipient and a preferred order in which the recipient is to view the web pages." (3:7-8.)

Carter

2a. Carter discloses that "e-mail attachments have expanded to include web pages (e.g., HTML (hypertext markup language) documents) and URL's (universal resource locators) for web pages." (Col. 1, ll. 50-53.)

2b. Carter discloses that "the sender transmits the e-mail message and attaches files(s) to a receiver. When the receiver reads the message, there is an indicator that one or more files are attached. The receiver activates the attach button and is presented with a dialogue box that enables the receiver to retrieve the attached file or files" (Col. 3, ll. 21-27.)

§ 112, second paragraph as being withdrawn per the Advisory Action dated May 3, 2007.

Bates

3a. Bates discloses that “[c]heckbox 402g is entitled ‘customizable preferences of browser.’ Such preferences include color, sound, finds, display attributes and the like.” (Col. 7, ll. 13-15.)

3b. Bates discloses that checkboxes 402b-g and 402k may be similarly configured to further define the browser information to be sent/received.” (Col. 7, ll. 31-33.)

ANALYSIS

§ 112, second paragraph Rejection

The Examiner rejects claim 2 as being vague and indefinite because it is unclear what is the association and/or relationship between the web page and the email (Ans. 3).

Appellants respond that “112, 2nd paragraph [does not] require the claims to recite how something is associated.” (App. Br. 9.) We agree with Appellants.

We find that while claim 2 is written very broadly in reciting *a web page navigation associated with the email*, which can equate to any type of association/relationship, such broad language does not in itself make the claim indefinite. The test for definiteness under 35 U.S.C. § 112, second paragraph is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc., v. Safety Travel Chairs*, 806 F.2d 1565, 1576 (Fed. Cir. 1986)(citations omitted).

Here, Appellants’ Specification notes that “[t]he navigation is associated with the email, for example by use of an identification number or

by incorporation into the email” (Spec. 3:8-9). Thus, we find that, with this example, one skilled in the art would understand what is claimed with regards to the type of association between the web page navigation and the email in light of the specification.

Thus, Appellants have persuaded us of error in the Examiner’s conclusion of indefinite for representative claim 2. Therefore, we reverse the Examiner’s § 112, second paragraph rejection of independent claim 2.

§ 102(e) Rejection

We selected claim 1 as representative of the claims on appeal. For claims 2, 3, 5, 7, 9-11, 13, 15, and 17-20, Appellants in essence repeat the same argument made for claim 1. We will, therefore, treat claims 2, 3, 5, 7, 9-11, 13, 15, and 17-20 as standing or falling with claim 1.

Issue 1: Did the Examiner err in finding that Carter discloses “generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient?”

Appellants contend that “[r]etrieving a file attached to an e-mail is simply not the same as receiving a navigation attached to an e-mail, much less, a navigation including URLs in a preferred viewing order.” (App. Br. 13)

The Examiner found:

Carter teaches entering one URL and attaching it and then attaching another if needed. This would be the “preferred viewing order.” The claim language does not state what the order is or how it is displayed or how the “navigation” is set up at the recipients end. Therefore, it can be interpreted that the “preferred order” is the order in which the web pages were attached, as stated in Carter, and the navigation appears to be the attachments themselves or web pages that the user selects.

(Ans. 18.) We agree with the Examiner.

Here, claim 1 does not describe how the “preferred order” is identified or what the “navigation” looks like. Therefore, the Examiner found that a “preferred order” can simply be the order in which the attachments are presented in the e-mail and the attachment header can be the navigation. We agree.

Appellants’ Specification supports the Examiner’s conclusion because the Specification itself notes that the “preferred order” can be the order in which URLs appear in the navigation (FF 1a) and that a “navigation” simply includes a set of URLs that identify web pages to be viewed by the recipient (FF 1b).

During examination, claims are to be given their broadest reasonable interpretation consistent with the specification, and the language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Amer. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted). The Office must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. *Id.* (citations omitted).

Here, the Examiner’s interpretation is consistent with Appellants’ Specification. Furthermore, Appellants acknowledge that Carter discloses

sending an e-mail with attached HTML documents (App Br. 35). For example, Carter discloses e-mails having URL attachments being transmitted to recipients where the attachment button is activated (i.e., navigation to the URL)(FF 2a-2b). Further, Appellants have not shown how the claimed navigation is distinguishable from the Carter's e-mail attachment header. Thus, the claimed "sending the email and the web page navigation" reads on Carter's email with attachments.

Based on the record before us, we find that the Examiner did not err in rejecting representative claim 1. Accordingly, we affirm the rejection of claims 2, 3, 5, 7, 9-11, 13, 15, and 17-20.

103(a) Rejection

Claims 8 and 16

For independent claims 8 and 16, Appellants present the same arguments as presented *supra* for claim 1 (App. Br. 34-37), which we have found unpersuasive. We note that arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. Therefore, we also affirm the rejection of claims 8 and 16 for reason set forth above.

Claims 4, 6, 12, and 14

Issue 2: Did the Examiner err in finding that the combination of Carter and Bates discloses the preferred viewing order is provided by link colors and/or by font characteristics?

Appellants contend that “Bates is entirely silent with regard to link colors that provide an indication of the preferred viewing order” (App. Br. 38)(e.g., claims 4 and 12) and “Bates is entirely silent with regard to font characteristics that provide an indication of the preferred viewing order” (*id.*)(e.g., claims 6 and 14).

The Examiner found that “utilizing what is known by Carter, in combination with Bates, the user may apply colors or different display attributes for each web page attached to the email.” (Ans. 20.) We agree.

Here, the Examiner relies upon Carter to show the preferred viewing order and Bates to disclose customization of items using color and font characteristics (Ans. 20), i.e., the combination of teachings. However, Appellants appear to be attacking Bates individually. The test for obviousness is what the combined teachings of the references would have suggested to the artisan. Accordingly, one can not show nonobviousness by attacking references individually where the rejection is based on a combination of references. *In re Keller*, 642 F.2d 413, 426 (CCPA 1981).

As noted *supra*, Carter discloses an implicit preferred viewing order. Bates discloses the ability to customize browser items based on color and display attributes (FF 3a-b). Thus, the Examiner has shown, and we agree, that the *combined* teachings of Carter and Bates reasonably suggest that a preferred viewing order can be provided by color and/or font characteristics.

Thus, Appellants have not persuaded us of error in the Examiner’s conclusion of obviousness for representative claims 4 and 6. Therefore, we affirm the Examiner’s § 103 rejection of claims 4, 6, 12, and 14.

DECISION

We reverse the Examiner's § 112, second paragraph rejection of claim 2.

We affirm the Examiner's § 102 and § 103 rejections.

Since at least one rejection encompassing all claims on appeal is affirmed, the decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED

Erc

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